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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/802,472	02/18/97	KORMANIK	C

PM82/0321

PETER K TRZYNA
P O BOX 7131
CHICAGO IL 60680-7131

EXAMINER	
LUBY,M	
ART UNIT	**PAPER NUMBER**
3618	

DATE MAILED: 03/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/802,472	Applicant(s) Kormanik, Jr.
	Examiner Matthew Luby	Group Art Unit 3618

☒ Responsive to communication(s) filed on *Mar 3, 2000* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *5 and 8-31* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *5 and 8-31* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *Aug 6, 1999* is ☒approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Claims 1-4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected group. Election was made **without** traverse in Paper No. 9 and affirmed in Paper No. 14.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor ofs carrying out his invention.

3. Claims 5 and 8-31 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

The claims are not supported by either a specific asserted utility or a well established utility because claims 5 and 24-26 recite "the shape of the package being suggestive of an activity in which the article can be used" (claim 5, lines 8-9); "providing an object in a package resembling a particular ball and suggestive of a particular activity associated with said ball" (claim 24, lines 3-4); "locating the article within the hollow interior of the package, the article having a use related to an activity suggested by the shape of the package to form a combination of the article and the thematically-shaped packaging" (claim 25, lines 7-9); "constructing the package as a replica of a

golf ball such that the shape is suggestive of the activity of a game of golf" (claim 25, lines 11-12); "constructing the package as a replica of a symbol having a shape that is suggestive of an activity, the package having a hollow interior to form the packaging for the article" (claim 26, lines 4-6) and "constructing the package as a replica of a baseball such that the shape is suggestive of the activity of a baseball game" (claim 26, lines 12-13). These limitations do not define a particular utility in view of the usage of the word "suggestive". This recitation is considered a mental step which cannot be assigned any specific utility or well established utility. Note, because the claimed invention is not supported by a specific asserted utility for the reasons set forth above, credibility cannot be assessed.

Claims 5 and 8-31 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

4. Claims 5 and 8-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following limitations: "the shape of the package being suggestive of an activity in which the article can be used" (claim 5, lines 8-9); "providing an object in a package resembling a particular ball and suggestive of a particular activity associated with said ball" (claim 24, lines 3-

4); "locating the article within the hollow interior of the package, the article having a use related to an activity suggested by the shape of the package to form a combination of the article and the thematically-shaped packaging" (claim 25, lines 7-9); "constructing the package as a replica of a golf ball such that the shape is suggestive of the activity of a game of golf" (claim 25, lines 11-12); "constructing the package as a replica of a symbol having a shape that is suggestive of an activity, the package having a hollow interior to form the packaging for the article" (claim 26, lines 4-6) and "constructing the package as a replica of a baseball such that the shape is suggestive of the activity of a baseball game" (claim 26, lines 12-13) are considered vague and indefinite. It is uncertain as to which shape is suggestive and which is not.

The recitation "the step of constructing the replica to have additional utility includes..." (claim 22, lines 1-2) lacks proper antecedent basis.

The recitation "constructing the replica to be capable of..." (claim 22, line 3) is vague and indefinite because it has been held that the recitation that an element "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison,* 69 USPQ 138.

Claim 22 is vague and indefinite for failing to point out what "constructing ...to be capable of receiving...writing". It is uncertain as to exactly which surface can receive writing and which cannot.

The recitation "from a group including a wiping cloth, a rain coat..." (claim 24, lines 5-9) is indefinite. The language amounts to an improper Markush group, one which does not specify

the particular species of the object. It is suggested that the claim be amended to properly recite the elements of the group or the language be deleted from the claim so that applicant might more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the aforementioned are merely examples to make the applicant aware that in general the claims of record are replete with vague and indefinite limitations. It is suggested that applicant thoroughly review all limitations within the claims and re-write them to positively set forth all method steps as well as functional and structural limitations.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 24-26 and 31 recite the broad recitations "an object" (claim 24, line 3); "a package" (claim 25, line 4) and "the package" (claim 26, line 4), and

the claim also recites "a particular ball" (claim 24, line 3); "a golf ball" (claim 25, line 11) and "a baseball" (claim 26, line 12) which are the narrower statements of the range/limitation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 5, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Agapiou (4,815,607).

Agapiou discloses the claimed method for making a package and article including constructing the package as a "recognizable icon" (10) which has a shape different than the shape of the article inside (the package is a tire and the article is a toy - see Figure 3, for example) and is hollow (see Figure 2), the shape of the package is "suggestive of an activity" (all shapes are suggestive of some activity; in this case the tire shape is suggestive of a safety activity for learning about safety procedures around motor vehicles) and locating the article within the hollow interior of the package (col. 2, lines 4-6).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 8-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agapiou.

Agapiou discloses the claimed method including the package and article as described above. Agapiou does not particularly recite that the package resembles a particular ball, that the article is selected from the group including a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a pancho, a hat and a seat cover; that the package is constructed as either a replica of a golf ball, a baseball, a life preserver, a football, a tennis ball, a soccer ball, a rugby ball or a charge/bank card and that the article is rain gear. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Agapiou reference by having the package resemble a particular ball, that the article is selected from the group including a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a pancho, a hat and a seat cover; that the package is constructed as either a replica of a golf ball, a baseball, a life preserver, a football, a tennis ball, a soccer ball, a rugby ball or a charge/bank card and that the article is rain gear, since a person of ordinary skill in the art at the time of the invention would provide a package with an article inside to resemble objects useful to the target consumer(s) who would purchase these items. It is notoriously well known to place rain gear or any other article, for that matter, inside a

package. Further it is also well known to construct that package to resemble a familiar symbol to the target consumer(s).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on the attached Form 892.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Luby whose telephone number is (703) 305-0441. The examiner can normally be reached weekdays from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

m.l. ML

March 14, 2000
Matt Luby

BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

3/20/00